

Seamless I and Seamless II Are Improper Prior Art Citations

The Seamless I article is dated January, 2001. The Seamless II article is dated March 2001. The present application was filed on June 16, 2000. Accordingly, the Seamless I and Seamless II articles do not constitute proper prior art.

A printed publication is prior art under 35 U.S.C. § 102(a) if it was published prior to the date of the invention. See 35 U.S.C. § 102(a). In addition, the Manual of Patent Examining Procedure specifies that “All printed publications may be used as references, the date to be cited being the publication date.” MPEP § 901.06 (emphasis added).

The publication date for the Seamless I article is more than six months after the filing date of the present application. The publication date for the Seamless II article is more than eight months after the filing date of the present application. Accordingly, neither article constitutes proper prior art with regard to the present application.

The Examiner improperly relies on a date mentioned in the body of the Seamless II article, which states: “Finger and his lawyer pal Paul Appelbaum formed SeamlessWeb in December 1999.” However, there is no suggestion that the content of either the Seamless I or the Seamless II article was publicly known or even conceived of by the founders of Seamless Web as of this December 1999 date improperly relied on by the Examiner. In fact, the Seamless I article, which predates the Seamless II article that mentions the December 1999 date, indicates “SeamlessWeb’s current incarnation is appealingly simple to use.” (Seamless I, second page, last paragraph, line 39 (emphasis added)). Thus, it would appear that the Seamless I and Seamless II articles are describing the current versions of the Seamless Web system as of the respective publication dates of January 2001 and March 2001, as would be expected of such press release type articles.

Accordingly, withdrawal of the rejections under 35 U.S.C. § 103(a) is respectfully requested, in view of the improperly cited Seamless I and Seamless II articles.

In the event that the Examiner somehow disagrees with the foregoing arguments that the Seamless I and Seamless II articles are improper prior art and maintains his

position that the December 1999 date is applicable, Applicants submit herewith a Declaration Under 37 C.F.R. §1.131. The attached Declaration specifies that the Applicants conceived the present invention prior to December 1, 1999, and were diligent in their efforts to complete the invention from a time prior to December 1, 1999 up until the date of filing of the present application, June 16, 2000, and these efforts were continuous.

In particular, EXHIBITS 1 and 2 to the attached Declaration include NYORDER.COM Business Plans that provide a detailed description of Applicants' invention (NYORDER.COM was the predecessor of the assignee of the present invention, and the Business Plans of EXHIBITS 1 and 2 were prepared by the inventors of the present application). The NYORDER.COM Business Plan at EXHIBIT 1 describes the invention in connection with an online ordering system for takeout food. The "Overview" section of the NYORDER.COM Business Plan details the provision of online ordering services by allowing customers to browse menus from various restaurants by logging on to a web site. The customer can then place the order online with NYORDER.COM, which acts as an intermediary and forwards the order on to the restaurant (e.g., via fax or email). The restaurant will then process the order and deliver the food to the customer. The billing information is entered into the web site at the time the order is placed. The customer is then provided with an invoice for the orders placed from NYORDER.COM (see, e.g., first full paragraph on page 2 of NYORDER.COM Business Plan).

The NYORDER.COM Business Plan includes an Exhibit A, which contains descriptions of various web pages to be used in connection with the web site of the present invention. For example, the description for SCREEN ONE includes the input information required to identify the customer and/or the customer account, as well as input information for the address of the customer so that nearby restaurants that deliver to that area can be accessed. The description for SCREEN TWO includes input information for the order the customer is placing, that customer's past order history, and the time of delivery of the order. The description for SCREEN THREE includes the results from the

input of SCREEN TWO, including a list of restaurants broken down by food type, restaurant contact information, credit cards accepted, and provides the customer with an option to select one of the listed restaurants. The description for SCREEN FOUR includes the selected restaurant's menu with options for the customer to select menu items, as well as an indicator of the order's total cost. The description for SCREEN FIVE includes inputs for entry of payment or account information, instructions for delivery, information screen with restaurant contact information. In addition, the description for this screen indicates that after the payment/account information is approved, the order and payment information will be sent to the restaurant. The PROGRAM/DESIGN notes for SCREEN FIVE indicate that an accounting of food ordering activity (invoice) is to be provided to the customer or customer's company and that this accounting information can be organized in many different ways, by client, by restaurant, by client reference number, etc. This note also indicates that bills can be sent to the client on behalf of the restaurant.

Attached to the Declaration at **EXHIBIT 4** is a copy of an "Abbreviated Proposal" for work to be performed for NYORDER.COM by JPC Web Inc. a web site development firm. The Abbreviated Proposal at **EXHIBIT 4** was prepared by JPC Web Inc. prior to December 1999 and provides cost estimates for constructing a web site to implement the system described in the NYORDER Business Plan at **EXHIBIT 1**, including the web site screens described in Exhibit A to the Business Plan.

Attached at **EXHIBIT 3** to the Declaration is a copy of a certified copy of the articles of incorporation for NYORDER.COM, LLC, which were executed on October 6, 1999. The copy of the articles of incorporation attached at **EXHIBIT 3** bears a date stamp from the State of New York Department of State of October 14, 1999. It should be noted that the name of the company has changed several times over the years and is now Osmio, Incorporated, the assignee of the present invention.

It is noted that the Examiner relies only on a statement in Seamless II which indicates that Seamless Web was formed "in December 1999." Applicants' respectfully submit that the Examiner should give equal weight to the articles of incorporation

attached to Applicants' Declaration, which specify that Applicants company was formed in October of 1999.

Accordingly, the attached Declaration establishes that the Applicants conceived their invention (or at least the portions thereof relevant in view of the Seamless Web articles) prior to December 1999, the date mentioned in Seamless II as the date of formation of Seamless Web.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1-27 based on the Seamless I and Seamless II articles.

By swearing behind the Seamless I and Seamless II articles, Applicants do not admit that these articles are otherwise relevant to the present invention.

Applicant respectfully submits that with the removal of the Seamless I and Seamless II articles, claims 1-27 are in condition for immediate allowance.

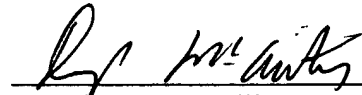
Further remarks regarding the asserted relationship between Applicants' claims and the prior art are not deemed necessary, in view of the foregoing discussion and the attached Declaration Under 37 C.F.R. § 1.131. Applicants' silence as to any of the Examiner's comments is not indicative of an acquiescence to the stated grounds of rejection.

Withdrawal of the rejections under 35 U.S.C. § 103(a) is therefore respectfully requested.

Conclusion

The Examiner is respectfully requested to reconsider this application, allow each of the pending claims and to pass this application on to an early issue. If there are any remaining issues that need to be addressed in order to place this application into condition for allowance, the Examiner is requested to telephone Applicants' undersigned attorney.

Respectfully submitted,



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